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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,905	12/09/2003	Dirk Sembritzki	4002-1024-1	3310
466 7590 03/19/2007 YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			EXAMINER SIMONE, CATHERINE A	
			ART UNIT	PAPER NUMBER
			1772	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/19/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

5

Office Action Summary	Application No. 10/729,905	Applicant(s) SEMBRITZKI ET AL.	
	Examiner Catherine Simone	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Withdrawn Rejections

1. The 35 U.S.C. 102 rejection of claims 12-18 as anticipated by Gerard of record in the previous Office Action mailed 9/22/06, Pages 2-3, Paragraph #3 has been withdrawn due to the Applicant's amendment filed 12/22/06.
2. The 35 U.S.C. 102 rejection of claims 12-18 as anticipated by Schulz of record in the previous Office Action mailed 9/22/06, Pages 3-4, Paragraph #4 has been withdrawn due to the Applicant's amendment filed 12/22/06.
3. The 35 U.S.C. 103 rejection of claims 12-18 over Gerard of record in the previous Office Action mailed 9/22/06, Pages 5-6, Paragraph #6 has been withdrawn due to the Applicant's amendment filed 12/22/06.

Repeated Rejections

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulz (EP 0 344 056).

Art Unit: 1772

Regarding claims 12-14 and 18, Schulz discloses laminated tissue paper comprising at least two tissue plies with substantially identical embossing patterns, the embossing patterns consisting of embossing protrusions, wherein the at least two plies are displaced relatively to each other in a displacement direction, and laminated with the protrusions of the plies extending in the same direction (*see col. 3, lines 20-45*).

Although Schulz teaches the two tissue plies being displaced relatively to each other in a displacement direction (*see col. 4, lines 11-23 and col. 5, lines 1-6*) to achieve high bulk, Schulz fails to disclose a maximum distance D in the displacement direction between an embossing protrusion of a first ply and an embossing protrusion of a second ply, which is displaced relative to the first one, being set as a function of the height H of the embossing protrusions and the length L of the embossing protrusions in the displacement direction so that D is equal to the smaller one of the values of $12H$ and $14L$, $8H$ and $10L$, and $6H$ and $8L$.

The optimum ranges for the maximum distance D in the displacement direction between an embossing protrusion of the first ply and an embossing protrusion of the second ply would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end results. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the two tissue plies in Schulz to have a maximum distance D in the displacement direction between an embossing protrusion of the first ply and an embossing protrusion of the second ply, which is displaced relative to the first one, set as a function of the height H of the embossing protrusions and the length L of the embossing protrusions in the displacement direction so that D is equal to the smaller one of the values of $12H$ and $14L$, $8H$ and $10L$, and $6H$ and $8L$, since it has been held

Art Unit: 1772

that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. *MPEP 2144.05 (II)*.

Regarding claim 15, note at least one further tissue ply, which is superimposed to the laminated tissue paper (*see col. 4, lines 14-23 and line 63*). Regarding claim 16, note at least one further tissue ply is another laminated tissue paper (*see col. 4, lines 14-23 and line 63*).

Regarding claim 17, note the plies are laminated by mechanical ply bonding (*see col. 3, lines 46-48*).

New Rejections

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "*the laminated tissue paper has a greater softness and a greater thickness than when the maximum distance D is equal to the smaller one of the values of 12H and 14L than when the maximum distance D is not equal to the smaller one of the values of 12H and 14L*" in new claim 19 is deemed new matter. In Applicant's remarks filed 12/22/06, Applicant states support for the new claim 19 "may be found generally throughout the specification, particularly at page 11, 3rd

Art Unit: 1772

paragraph, and the originally filed claims". However, the Examiner is unable to find support for this new limitation in the specification.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schulz (EP 0 344 056).

Schulz discloses laminated tissue paper comprising a first tissue ply and a second tissue ply wherein the first and second plies have substantially identical embossing patterns, the embossing patterns consisting of embossing protrusions, the first ply and second ply are displaced relatively to each other in a displacement direction, and laminated with the protrusions of the plies extending in the same direction (*see col. 3, lines 20-45*).

Although Schulz teaches the first ply and second ply being displaced relatively to each other in a displacement direction (*see col. 4, lines 11-23 and col. 5, lines 1-6*) to enhance bulk and softness, Schulz fails to disclose a maximum distance D in the displacement direction between an embossing protrusion of the first ply and an embossing protrusion of the second ply being equal to the smaller one of the values of 12H and 14L.

Art Unit: 1772

The maximum distance D in the displacement direction between an embossing protrusion of the first ply and an embossing protrusion of the second ply would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end results. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the two tissue plies in Schulz to have a maximum distance D in the displacement direction between an embossing protrusion of the first ply and an embossing protrusion of the second ply equal to the smaller one of the values of 12H and 14L, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. *MPEP 2144.05 (II)*. Furthermore, a greater thickness and a greater softness of the laminated tissue paper in Schulz would result when the two tissue plies are modified to have a maximum distance D in the displacement direction between an embossing protrusion of the first ply and an embossing protrusion of the second ply equal to the smaller one of the values of 12H and 14L. Also, it is to be pointed out that mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. See *MPEP 2145 (II)*.

Response to Arguments

10. Applicant's arguments filed 12/22/06 have been fully considered but they are not persuasive.

Applicant argues "Shulz fails to render obvious the present claims.... Shulz actually teaches away from the recited value of D, as Shulz achieves a thickness essentially the same as

Art Unit: 1772

embossed two-ply paper that has not been separated and rejoined (e.g. as shown in Figure 6A of the present application)".

However, the Examiner fails to see how Schulz teaches away from the recited value of D. First, the process for producing the laminated tissue paper in Schulz (col. 4, lines 10-24 and 62-65 and col. 5, lines 1-6) is very similar to the process disclosed in Applicant's specification (see pages 5-6 of Applicant's Specification). Second, the two tissue plies in Schulz are longitudinally displaced relative to one another so that the embossments are out of register with one another and nesting of the embossments is prevented (col. 3, lines 30-36 and col. 5, lines 1-6), which is also similar to that of the laminated tissue paper disclosed in Applicant's specification (see page 5, third paragraph and page 6, first and second paragraphs). Third, the laminated tissue paper in Schulz is taught to have an increase in bulk and softness (col. 2, lines 49-50 and col. 5, lines 5-6). Overall, the laminated tissue paper in Schulz is very similar to the laminated tissue paper disclosed in Applicant's present invention except for the fact that Schulz is silent to a maximum distance D in the displacement direction between an embossing protrusion of the first ply and an embossing protrusion of the second ply being equal to the smaller one of the values of 12H and 14L.

Although Schulz fails to teach a maximum distance D in the displacement direction between an embossing protrusion of the first ply and an embossing protrusion of the second ply being equal to the smaller one of the values of 12H and 14L, again the method for producing the laminated tissue paper web in Schulz is very similar to that disclosed in Applicant's Specification and the laminated tissue paper in Schulz has enhanced bulk and softness. Therefore, it would have been obvious to one of ordinary skill in the art at the time the

Art Unit: 1772

applicant's invention was made to have modified the two tissue plies in Schulz to have a maximum distance D in the displacement direction between an embossing protrusion of the first ply and an embossing protrusion of the second ply equal to the smaller one of the values of 12H and 14L, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. *MPEP 2144.05 (II)*. Furthermore, a greater thickness and a greater softness of the laminated tissue paper in Schulz would result when the two tissue plies are modified to have a maximum distance D in the displacement direction between an embossing protrusion of the first ply and an embossing protrusion of the second ply equal to the smaller one of the values of 12H and 14L.

Additionally, Applicant has provided no showing of unexpected results. Unexpected results must be established by factual evidence. Evidence of unexpected properties may be in the form of a direct or indirect comparison of the claimed invention with the closest prior art, which is commensurate in scope with the claims. See *MPEP 716.02(b)* and *716.02(e)*. Thus, the claims fail to patentably define over the prior art as applied above.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See *MPEP* § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after


Art Unit: 1772

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571)272-1501. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Catherine A. Simone
Examiner
Art Unit 1772
March 12, 2007


NASSER AHMAD
PRIMARY EXAMINER 3/14/07